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Rule 52(a) is quoted immediately below:

“Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b).”

IN THE
Supreme Court of the United States

No.

October Term, 1948

HAZELTINE RESEARCH, INC.,
Petitioner,

vs.

GENERAL MOTORS CORPORATION,
Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT.**

*To the Honorable the Chief Justice and Associate Justices
of the Supreme Court of the United States:*

Your Petitioner, Hazeltine Research, Inc., by its undersigned attorneys, respectfully prays that a Writ of Certiorari issue to the United States Court of Appeals for the Sixth Circuit to review the Judgment of that Court in the above cause. On October 19, 1948, the Court of Appeals filed an Opinion (R 1747; 170 F. (2d) 6) affirming a Judgment of the District Court for the Eastern District of Michigan, Southern Division (R 1719; 72 F. Supp. 138) dismissing Petitioner's Complaint. A timely Petition for Rehearing (R 1753) was filed and denied by the Court of Appeals without opinion (R 1765) on November 29, 1948. A Renewed

Petition for Rehearing (R 1765) was filed on December 13, 1948, and denied in a *per curiam* Opinion (R 1768) on December 27, 1948.

A certified transcript of the record including the proceedings in the said Court of Appeals is furnished herewith in accordance with the provisions of Rule 38 of this Court.

I. Summary Statement of the Matter Involved.

On January 30, 1941, Petitioner filed its Complaint (R 5) charging infringement of Claims 1, 2, 3, 5, 6, and 8, of Wheeler patent 1,951,685 (R 889)* by radio receivers manufactured and sold by Respondent. The patent in suit matured from a divisional application of a parent application, Serial No. 203,879, filed July 7, 1927 (R 1371). The patented invention is a detector for a radio broadcast receiver; that is, a device which separates from the inaudible high-frequency radio wave picked up by the receiver, an audible relatively low-frequency wave which is reproduced in the loudspeaker.

The case was heard by Judge LEDERLE in February, 1947. At the trial there was extensive uncontradicted fact testimony by leading workers in the radio art at the time the invention was made, to the effect that the invention of Patent 1,951,685 "was to me a complex step forward in the art" (R 202); that "It was not at all obvious that it was a simple substitution" (R 233); that "It meant new concepts" (R 248); and that "There is here a radically new conception of detector action" (R 2072).

* Another complaint (R 67) was filed, charging Respondent with infringement of Patent 2,041,273 (R 903) and the two cases were consolidated for trial. The decisions of the District Court and the Court of Appeals did not distinguish between the two patents but the aforesaid Petition for Rehearing in the Court of Appeals was based only on Patent 1,951,685; therefore, Patent 2,041,273 is not before this Court on this Petition.

There was also introduced extensive uncontradicted fact testimony that the patented invention was first introduced to the art by Petitioner's predecessor in 1929-1930 and that the first commercial radio receivers embodying the invention and produced in quantity were designed by the patentee, Wheeler, for Philadelphia Storage Battery Company (Philco) which became its famous Model 95 receiver (Exh. 20—R 1081; R 192-193). Since that time, the patented invention has gradually supplanted all other types of detectors for radio receivers (R 254, 1084).

The decision of the District Court, holding the patent invalid, presented a *very unusual situation*. That Court made clear its independent judgment that, on the record, Petitioner had established validity and infringement and was entitled to a recovery. However, it considered itself constrained by the decision of this Court in *Detrola v. Hazeltine* (313 U. S. 259) to find the subject-matter obvious and the patent hence invalid.

An analysis of the findings of the District Court shows that it did not find that the claims of the patents in suit were anticipated; it did not find any formal deficiencies in the patent specifications or claims; and it did not find any lack of infringement. On the contrary, the District Court concluded that the subject matter involved was so technical that it had to rely largely on the testimony of the experts; it found that the integrity of all of the witnesses was beyond criticism; but it found that Petitioner's experts, Professor Hazeltine and Mr. Wheeler, and its fact witnesses, Messrs. Wise, Cotter, and Hirsch, were better qualified to speak with authority than Respondent's sole witness, Mr. Kelley, saying: "... But as contrasted with Wheeler and Hazeltine, I doubt whether you can put him (Kelley) in the same class" (R 879). Finally it concluded that, on the basis of

such testimony, Petitioner "had made out a pretty good case here".*

* For the convenience of this Court, the pertinent portions of the remarks of Judge LEDERLE are reproduced here:

"We have two separate patents in suit here. They were disclosed to the Patent Office sometime in 1926 or 1927, I believe it was. So, we are talking about the radio art as it existed 20 years ago, not today.

"The only way I know to find out about what the state of the art was at that time is to examine the literature of that day, and to listen to witnesses who knew what was going on at that time.

"On behalf of the plaintiff here, take Professor Hazeltine as one witness. I presume that Professor Hazeltine, at least, has a mild interest in the outcome of this lawsuit, but, on the other hand, I saw no evidence that he colored any of his testimony at any time to favor his side of the case.

"I think, probably, Professor Hazeltine should be classified as both a fact witness and an expert witness, as the term is sometimes used in patent cases. I know of no instance that, so far as being a fact witness, he did not testify exactly as he saw the facts, or as he recalled the facts as they existed at that time.

"I don't think there is any dispute but that on the record here I would have to find he was the leader in the radio art at that time, and that he still is competent to testify.

"With reference to his standing as an expert, I think I should have to find that, so far as this record is concerned, his standing in the radio field was, as of the date that the patent was applied for, and even as of this date, among the highest.

"Professor Hazeltine saw an advance in the claims that are involved in this suit over the prior art.

"We have Mr. Wheeler who testified. Mr. Wheeler might have a greater interest in the outcome of this suit. Still, I have no reason to feel that in either part of his testimony he colored it intentionally. Of course, as Aesop said a good many years before the birth of Christ, 'We were wont to see things as we wish them to be,' and I suppose a judge or a jury should always have that in mind.

"Mr. Wheeler had a pretty good picture of the radio art as of the time he was working in it, at the time he made this disclosure. He likewise has some ability as an expert.

"Then we have the other witnesses that I won't go over individually, but who were active in the radio field at that time.

"On the other side of the picture we have Mr. Kelley. As I recall it, Mr. Kelley did have some experience in the last World War; later went into the radio business more extensively. But

(Continued on p. 5)

The inescapable conclusion from the foregoing analysis is that Petitioner had established the validity of the patents in suit to the independent satisfaction of the Trial Court. Nevertheless, it held the patent invalid *solely* on the basis of the decision in the *Detrola* case, a suit between different parties, involving a different patent containing claims to different subject matter, different reference citations and necessarily different proofs.

But the *amazing* aspect of the conclusion of the Trial Court is that it made no effort to point out the similarities or differences in the issues (claims) involved in the *Detrola* case and in the instant case; it made no effort to point out the application of any of the references relied upon in either the *Detrola* case or the instant case to the claims in suit in

(Continued from p. 4)

as contrasted with Wheeler and Hazeltine, I doubt whether you can put him in the same class.

"That is the reason why it is dangerous for one court to take findings of fact from another court. You never know what the record in the other court was. You never know how the witnesses in the other proceedings affected that particular judge or particular jury.

"Then, in addition to that, you have the fact that the Patent Office allowed the patents. It is true they had—or at least one of them had what the court sometimes referred to as a tempestuous career through the Patent Office. I am not certain that that detracts from the validity of the claims. I am not so certain that that may not be an indication of the validity of the claims. If they were strenuously opposed and eventually the examiner decides that they have virtue, it may be an indication that there was more virtue in the claim than one that was passed more or less as a matter of course.

"But I don't know how significant that fact is; at this time, I mean, I don't know what weight I should give to it.

"I don't think I know any more about the radio art than Judge Learned Hand does. I think the statement that he made, that this is a field where we have to rely upon experts, at least is as applicable to me as it is to Judge Hand.

"*To view it solely from the point of view of experts, it would seem that the plaintiff had made out a pretty good case here*" (R 878-880). (Emphasis added.)

this case; and it made no effort to point out the similarities or differences in the proofs in the *Detrola* case and in the instant case. Instead, it rested its decision solely on the following generalization:

“9. The advance over the prior art, if any, disclosed in two patents in suit is much less than was disclosed in the *Detrola* case. Applying the standard of invention established by that case in the radio field, it is obvious that all Wheeler did was to accomplish an old result by a combination of means which singly or in similar combination were disclosed by the prior art. None of the claims in suit of either patent discloses an advance over the prior art beyond that which could be accomplished by a mechanic skilled in the art. All of the claims in suit are void for want of invention” (R 1726).

In comparing the advance over the art represented by the patent involved in the *Detrola* case with that represented by the patents in suit, the District Court was attempting to compare two wholly unlike things. It is submitted that the quoted Finding is directly contrary to the Court's own analysis of the proofs in this case, reproduced above.

The Court of Appeals in its Opinion (R 1747), did not follow the conclusion of the District Court but affirmed the dismissal of the Complaints on the *wholly new ground* that manufacture, sale, and publication, more than two years prior to the filing of the divisional application of the patent in suit invalidated the patent. This conclusion of the Court of Appeals was bottomed upon its finding that the only disclosure in the original patent application carried over into the divisional applications was that of Figs. 1 and 2 of the patent drawings, as appears from its statement:

“The Appellant is forced to rely upon the statement that Figures 1 and 2 disclose all the essential ele-

ments of Wheeler's diode peak detector. This is not enough, and *there is nothing else.*" (R 1752; emphasis added.)

This purported manufacture, sale, and publication more than two years prior to the patentee's first disclosure of his inventions to the Patent Office was an issue which was not pleaded; it was not briefed or argued by either party;* and it was not considered by the Trial Court.

Moreover, the finding of the Court of Appeals quoted above is directly contrary to Findings of Fact of the Trial Court (*infra*, pp. 16-18); it is contrary to the factual situation contended for by Respondent in both the District Court and Court of Appeals; and it is completely contrary to the record.

* "While the Court of Appeals in its opinion denying rehearing (R 1768) stated that Senior Counsel of Respondent had argued this issue, actually the argument referred to (no transcript was taken) followed closely Respondent's Brief in the Court of Appeals and was limited to its contention that if the *claims* in suit were first introduced into the application more than two years after public sale, etc., the patents were invalid. Thus Respondent's Brief (at p. 59) stated:

"That the claims are invalid if the alleged invention is for the first time *claimed* more than two years after a public use or sale of the device which they are claimed to cover, has been expressly held in *Muncie Gear Works, Inc. v. Outboard Co.*, 315 U. S. 759 at pages 767-8.'" (Emphasis Respondent's.)

The Court of Appeals rejected *this* contention saying:

"The rule is that 'where an invention clearly disclosed in an application . . . is not claimed therein but is subsequently claimed in another application, the original will be deemed a constructive reduction of the invention to practice and the later one will be given the filing date of the earlier with all its priority of right.' *Chapman v. Wintroath*, 252 U. S. 126. No excuse need be shown for the delay in filing the divisional claims in the absence of intervening adverse rights. *Crown Cork Co. v. Gutmann Co.*, 304 U. S. 159; *General Pictures Co. v. Electric Co.*, 304 U. S. 175, 182" (R 1749).

In view of the clear error of fact on which the decision of the Court of Appeals was based, Petitioner filed its Petition for Rehearing (R 1753) in which the errors of fact of the Court of Appeals were painstakingly pointed out. When that Petition was denied without opinion, Petitioner filed its Renewed Petition for Rehearing (R 1765) in an urgent attempt to obtain a rectification of the serious errors. While the Court of Appeals denied Petitioner's Renewed Petition for Rehearing in an Opinion (R 1768) of marked acerbity, it must be regretfully pointed out that that Court evaded the real issues in that it made no attempt to meet the straightforward and irrefutable analysis of the facts of record contained in both the Petition for Rehearing and the Renewed Petition.

Thus, neither the Trial Court nor the Court of Appeals decided, on their merits, the issues of validity and infringement squarely presented to them. An important patent of Petitioner has been stricken down without due judicial consideration of its merits.

II. Jurisdiction.

The grounds on which the jurisdiction of this Court is invoked are as follows:

(1) The statute under which this jurisdiction is invoked is Title 28 U. S. Code, Sec. 1254.

(2) The Opinion (Judgment) of the Court of Appeals for the Sixth Circuit denying Petitioner's Renewed Petition for Rehearing was filed December 27, 1948 (R 1768). That is the date from which the time for making application for Certiorari to this Court begins to run (*The Gypsy Oil Co. v. Escoe*, 275 U. S. 498). This Petition for Writ of Certiorari is being presented on or about February 21, 1949.

(3) The foregoing Opinion of the Court of Appeals and the antecedent Opinion of that Court of October 19, 1948 (R 1747), represent clear violations of Rule 52(a) of the Rules of Civil Procedure promulgated by this Court pursuant to statute (Title 28 U. S. Code, Sec. 2072).

(4) The issuance of Writs of Certiorari by this Court in each of the following cases, involving the failure of a Court of Appeals to follow a Finding of Fact of the District Court unless "clearly erroneous" as prescribed by aforesaid Rule 52(a), is believed to sustain the jurisdiction of this Court in this case:

Walling v. General Industries Co., 330 U. S. 545, 551;

Adamson v. Gilliland, 242 U. S. 350, 353.

III. Questions Presented.

The sole question presented by this Petition is:

Where a District Court has made an express Finding of Fact based upon uncontradicted evidence which the reviewing Court of Appeals does not find clearly erroneous, does the Court of Appeals violate Rule 52(a) of the Rules of Civil Procedure by making a Finding of Fact directly contrary to said Finding of Fact of the District Court and basing its decision solely thereon?

IV. Reasons Relied Upon For Allowance of Writ of Certiorari.

The discretionary power of this Court is invoked upon the following grounds:

- (1) *The Court of Appeals for the Sixth Circuit has decided a question of general importance relating to the application of the Rules of Civil Procedure promulgated by this Court pursuant to a statute of the United States.***

It is submitted that the opinion of the Court of Appeals (R 1747) constitutes a direct violation of Rule 52(a) of the Rules of Civil Procedure promulgated by this Court pursuant to Title 28 U. S. Code, Sec. 2072. The question of law presented in the application of the foregoing Rule is of great public importance and frequently arises in general practice before the several Courts of Appeals. If a general disregard of such Rules of Civil Procedure is permitted, the effect would be eventually to nullify the salutary purposes of such Rules.

- (2) *The decision of the Court of Appeals of the Sixth Circuit is contrary to the provisions of Rule 52(a) of the Rules of Civil Procedure.***

Rule 52(a) provides that Findings of Fact of the Trial Court shall not be set aside "unless clearly erroneous". In this case the Court of Appeals did not hold that the Findings of the District Court were clearly erroneous and yet it made a purported Finding of Fact directly contrary to that of the District Court and based its decision solely on such erroneous Finding.

- (3) *The decision of the Court of Appeals of the Sixth Circuit is in conflict with decisions of this Court.***

While Rule 52(a) of the Rules of Civil Procedure is clear and unambiguous on its face, this Court has had occa-

sion in several cases arising both under the old equity practice and under the present Rules of Civil Procedure, unequivocally to affirm the natural meaning of the language of the Rule. The decision of the Court of Appeals in the instant case is in conflict with such decisions of this Court, in certain of which this Court reversed the decisions of the Courts of Appeals which failed to recognize the binding nature of the Findings of Fact of the District Court unless "clearly erroneous":

Walling v. General Industries Co., 330 U. S. 545;
Tennessee Coal v. Muscoda Local, 321 U. S. 590
 (Rehearing denied 322 U. S. 771);
District of Columbia v. Pace, 320 U. S. 698;
Adamson v. Gilliland, 242 U. S. 350;
Davis v. Schwartz, 155 U. S. 631;
Warren v. Keep, 155 U. S. 265;
Furrer v. Ferris, 145 U. S. 132;
Tilghman v. Proctor, 125 U. S. 136.

- (4) *The decision of the Court of Appeals of the Sixth Circuit is in direct conflict with the overwhelming majority of the decisions of the same Court in other cases and of the other United States Courts of Appeals.***

The decided cases in which the Courts of Appeals have considered themselves bound by Findings of Facts of District Courts are legion; in the great majority of these cases the Courts of Appeals contented themselves by announcing the applicable rule of law as a mere quotation from Rule 52(a) in view of its clarity. Such cases are too numerous to cite, but in an Appendix to the Brief (pp. 23-29) there are contained short statements of the rule of law in question taken from a large number of such cases in which Certiorari was denied by this Court.

WHEREFORE, your Petitioner respectfully prays that a Writ of Certiorari be issued out of and under the Seal of this Court directed to the United States Court of Appeals for the Sixth Circuit, commanding said Court to certify and send to this Court on a date to be designated, a full and complete transcript of the record and all proceedings which said Court of Appeals had in this cause, to the end that this case may be reviewed and determined by this Court; that the Judgment of the Court of Appeals be reversed; and that Petitioner be granted such other and further relief as may be deemed proper.

HAZELTINE RESEARCH, INC.,
Petitioner.

By MILES D. PILLARS
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IN THE
Supreme Court of the United States

No. _____

October Term, 1948

HAZELTINE RESEARCH, INC.,
Petitioner,
vs.

GENERAL MOTORS CORPORATION,
Respondent.

**BRIEF IN SUPPORT OF PETITION
FOR WRIT OF CERTIORARI.**

I. The Opinions Below.

The District Court's opinion was in the form of Findings of Fact and conclusions of law (R 1719; 72 F. Supp. 138) and included a Judgment dismissing Petitioner's Complaint. The Opinion of the Court of Appeals for the Sixth Circuit affirmed the Judgment of the District Court (R 1747; 170 F. (2d) 6); a Petition for Rehearing (R 1753) was denied without opinion (R 1765); and a Renewed Petition for Rehearing (R 1765) was denied in a *per curiam* Opinion (R 1768; F. (2d)).

II. Jurisdiction.

The grounds on which the jurisdiction of this Court is invoked are set forth in the preceding Petition (*supra*, pp. 8 and 9) and for the sake of brevity are not repeated here.

III. Statement of the Case.

The nature of the action and the prior proceedings therein and the supporting facts are sufficiently stated in the preceding Petition (*supra*, pp. 2-8) and for the sake of brevity are not repeated here.

IV. Specification of Assigned Errors.

The errors which Petitioner will urge, if the Writ of Certiorari is issued, are that the Court of Appeals for the Sixth Circuit erred:

(1) In disregarding an express Finding of Fact of the District Court and, without holding such a Finding to be "clearly erroneous", making a wholly new Finding directly contrary thereto and in violation of Rule 52(a) of the Rules of Civil Procedure.

(2) In failing to follow the decisions of this Court, applying the provisions of Rule 52(a) of the Rules of Civil Procedure.

(3) In failing to follow decisions of the same Court in other cases and the decisions in other United States Courts of Appeals, in applying the provisions of Rule 52(a) of the Rules of Civil Procedure.

V. Argument.

(A) Summary of Argument.

The argument follows the reasons relied upon for issuance of the Writ of Certiorari in the preceding Petition (*supra*, pp. 9-11).

In brief, it is Petitioner's position that

(1) The action of the Court of Appeals in this case, in disregarding an express Finding of Fact of the District Court based on *undisputed evidence*, without holding such Finding "clearly erroneous", and in making a wholly new Finding directly contrary thereto, is a direct violation of Rule 52(a) of the Rules of Civil Procedure.

(2) The decision of the Court of Appeals in this case being based *solely* on an erroneous Finding of Fact and one made in violation of Rule 52(a) is also necessarily erroneous and must be set aside.

(3) Should this Court see fit to issue the Writ of Certiorari requested, it may either decide the case on its merits, since the complete record is before it, or it may remand the case to the Court of Appeals for decision on the merits in accordance with the Findings of Fact of the District Court.

(B) *The Court of Appeals has decided a question of general importance relating to the application of the Rules of Civil Procedure.*

The Opinion of the Court of Appeals involves an application of Rule 52(a) of the Rules of Civil Procedure promulgated by this Court pursuant to a statute of the United States (Title 28 U. S. Code, Sec. 2072). The question of law presented in the Court's interpretation of such Rule is of great public importance and frequently arises in general practice before the United States Courts of Appeals. As pointed out hereinafter, the Opinion of the Court of Appeals in this case, disregarding as it does an express Finding of Fact by the District Court, is in conflict with Rule 52(a).

This Court is urged vigilantly to curb any tendency of the Courts of Appeals to deviate from the Rules of Civil Procedure, a tendency which, if unchecked, will eventually nullify their salutary objectives.

It is submitted that this Court in its surveillance of the Actions of the Courts of Appeals should issue a Writ of Certiorari in this case to correct the grievous deviation of the Court of Appeals for the Sixth Circuit.

(C) *The decision of the Court of Appeals of the Sixth Circuit is contrary to the provisions of Rule 52(a) of the Rules of Civil Procedure.*

The conflict between the decision of the Court of Appeals in this case and Rule 52(a) may be clarified by a brief review of the essential differences in facts as found by the District Court and the Court of Appeals. The ultimate issue presented by the Court of Appeals was whether the disclosure of the invention of Patent 1,951,685 in suit (R 889) was found in the original application (R 1371) from which it was divided. If it was *not*, the admitted public use and sale of apparatus embodying the invention under license from Petitioner after the filing date of the original application (July 7, 1927), but more than two years prior to the filing of the divisional application (April 1, 1931), would constitute a statutory bar which would admittedly invalidate the patent in suit. However, if the disclosure of the invention of the patent in suit *was* found in the original application, then the effective date of the divisional application is carried back to that of the original application and the public use and sale referred to would be of no effect. The Court of Appeals correctly stated the law on this point:

“The rule is that ‘where an invention clearly disclosed in an application . . . is not claimed therein

but is subsequently claimed in another application, the original will be deemed a constructive reduction of the invention to practice and the later one will be given the filing date of the earlier with all its priority of right.' *Chapman v. Wintroath*, 252 U. S. 126. No excuse need be shown for the delay in filing the divisional claims in the absence of intervening adverse rights. *Crown Cork Co. v. Gutmann Co.*, 304 U. S. 159; *General Pictures Co. v. Electric Co.*, 304 U. S. 175, 182" (R 1749).

Now what were the facts? The disclosure of a patent comprises both its drawings and its "specification" or description. The District Court found:

"Figures 1 and 2 of the '685 patent in suit are substantially identical with their counterparts in the original application. * * *

"* * * Figures 1, 2, 3 and 4 of the '273 patent are substantially identical with their counterparts in the original application. *The accompanying descriptions in the specifications of both these patents are substantially identical with that appearing in the original application.*" (Finding No. 3, R 1721; emphasis added.)

The Court of Appeals found:

"The appellant is forced to rely upon the statement that figures 1 and 2 disclose all the essential elements of Wheeler's diode peak detector. That is not enough, and *there is nothing else.*" (R 1752; emphasis added.)

Again, in its Opinion on Rehearing, the Court of Appeals said:

"* * * Our considered judgment was based upon a careful consideration of the disclosure of the original application, and finding therein no descrip-

tion of the invention of the patent in suit and *adjudging the law to be that drawings alone are not sufficient to comply with the statutory imperative for full disclosure*, we held the divisional patent invalid. * * * " (R 1769; emphasis added.)

In brief, the District Court found that the drawings and specifications of the patent in suit were the same as those of the original, while the Court of Appeals found that the *drawings only* were the same. This Finding of the Court of Appeals is directly in conflict with that of the District Court and *is the critical fact upon which its entire decision is founded*. The Court of Appeals did not and could not hold that the Finding of the District Court was "clearly erroneous".

As a matter of fact, Figures 1 and 2 of the drawings, and substantially all of pages 2 and 3 of the specification, of the patent in suit were carried over *without change* from the original application. This correspondence is brought out clearly by Attachments 1, 2 and 3 (R 1764A, 1764B and 1764C) of the Petition for Rehearing (R 1753-1763). The portions of the specification carried over into the patent in suit *even included the sizes of the several circuit elements of the invention* (R 1764B, ll. 135-149). No witness on either side so much as suggested that this disclosure carried over from the original application was not sufficient to teach one skilled in the art to practice the invention. If the Court should have any doubt on this subject, it is urged to consider the eleven page Petition for Rehearing (R 1753-1763) which establishes so clearly by references to the record how indefensible is the purported Finding of Fact of the Court of Appeals.

On the other hand, Rule 52(a) states:

"Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the op-

portunity of the trial court to judge of the credibility of the witnesses."

Thus it is seen that the action of the Court of Appeals in this case is directly in conflict with Rule 52(a) and should be reversed.

(D) *The decision of the Court of Appeals of the Sixth Circuit is in conflict with decisions of this Court.*

The language of Rule 52(a) appears clear and unambiguous on its face yet, despite that fact, this Court has had occasion to act in prior cases to correct deviations of the Courts of Appeals.

The case of *Walling v. General Industries Co.*, 330 U. S. 545, involved a fact situation closely parallel to that of this case. In that case there was involved a charge that respondent was violating the Fair Labor Standards Act by failing to make overtime payments to certain of its employees. The District Court found that the employees enjoyed an exempt status. The Court of Appeals disagreed with the District Court's findings but found that the employees had been compensated in accordance with the Act and affirmed the District Court's Judgment for respondent. This Court decided that the District Court's findings should have been followed and, since that disposed of the case, did not consider other issues, saying:

"The District Court, having made findings substantially as stated above, proceeded to make additional findings of the existence of each of the facts on which an executive status, as defined by the Regulations, is made to depend.

"We believe that the evidentiary facts afford an adequate basis for the inferences drawn by the Court in making such additional findings. At the least, we think that in drawing such inferences the Court was not clearly wrong, and conclude that the findings should therefore have been left undisturbed. The Circuit Court of Appeals' rejection of those findings cannot rest on the conflicting testimony of petitioner's witnesses. The District Court heard the witnesses, and was the proper judge of their credibility."

This Court took similar action in the case of *Adamson v. Gilliland*, a case arising under the old equity practice in which findings of fact of a trial court enjoyed the status formally accorded to them by Rule 52(a). That case was a patent infringement suit involving a patent which had previously been sustained in another district in which both the plaintiff and defendant of the *Adamson* case were witnesses. Defendant gave additional testimony in the *Adamson* case to the effect that he was the prior inventor. The District Court held that the additional testimony would not have changed the Judge's opinion in the prior litigation and again sustained the patent. The Court of Appeals held that the District Court had merely yielded to the authority of the former decision and reversed. This Court granted Certiorari and upheld the District Court saying:

"Considering that a patent has been granted to the plaintiff the case is preeminently one for the application of the practical rule that so far as the finding of the master or judge who saw the witnesses 'depends upon conflicting testimony, or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable.' *Davis v. Schwartz*, 155 U. S. 631, 636."

To a similar effect are the following decisions of this Court.

Tennessee Coal v. Muscoda Local, 321 U. S. 590
(Rehearing denied 322 U. S. 771);

District of Columbia v. Pace, 320 U. S. 698;

Davis v. Schwartz, 155 U. S. 631;

Warren v. Keep, 155 U. S. 265;

Farrer v. Ferris, 145 U. S. 132;

Tilghman v. Proctor, 125 U. S. 136.

- (E) ***The decision of the Court of Appeals of the Sixth Circuit is in direct conflict with the overwhelming majority of the decisions of the same Court in other cases and of the other United States Courts of Appeals.***

There is a myriad of cases by the several Courts of Appeals which reiterate the provision of Rule 52(a) relative to the weight to be accorded findings of fact of a District Court. It is not practicable to refer to these cases individually but, for the convenience of the Court, there are collected in an Appendix (*infra*, pp. 23-29) a large number of citations in each of which this Court denied Certiorari, with a brief reference to the rule of law as stated therein.

The cases collected in the Appendix bring home forcefully just how much "out-of-step" the Court of Appeals' decision is in this case. This deviation of the Court of Appeals for the Sixth Circuit should be corrected by this Court.

VI. Conclusion.

In conclusion, therefore, it is submitted:

(1) The decision of the Court of Appeals in this case is founded on a purported but erroneous factual finding made in disregard of a contrary finding of fact by the District Court and without any holding that the finding of the District Court is "clearly erroneous".

(2) The purported but erroneous factual finding of the Court of Appeals is in direct conflict with Rule 52(a) of the Rules of Civil Procedure.

(3) The decision of the Court of Appeals in this case is in conflict with controlling decisions of this Court and further is in conflict with the overwhelming weight of authority of the several United States Courts of Appeals.

(4) For all of the foregoing reasons, this Court should issue a Writ of Certiorari to the Court of Appeals for the Sixth Circuit to rectify its serious error and to maintain the integrity of the Rules of Civil Procedure.

Respectfully submitted,

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PHILIP F. LaFOLLETTE,
LEONARD A. WATSON,
LAURENCE B. DODDS,
Of Counsel.

APPENDIX

CASES DECIDED BY THE UNITED STATES COURTS OF APPEALS INTERPRETING RULE 52(a) OF THE RULES OF CIVIL PROCEDURE

(Certiorari Denied by the Supreme Court
In Each Case)

Atwood v. Kleberg (C. C. A. 5, 1947), 163 F. (2d) 108, Cert.
Den. 332 U. S. 843

" * * * It would serve no useful purpose to discuss the various complaints in detail. It will be sufficient, after dealing briefly with some of the major ones to say of all the complaints that under Rule 52 of Rules of Civil Procedure, 'Findings of fact shall not be set aside unless clearly erroneous,' * * * "

Connolly v. Gishwiller (C. C. A. 7, 1947), 162 F. (2d) 428,
Cert. Den. 332 U. S. 825

" * * * At any rate, the question being solely one of fact, we are required under the now well established rules to accept the findings unless they are clearly erroneous. * * * "

Lowrey v. U. S. (C. C. A. 8, 1947), 161 F. (2d) 30, Cert. Den.
331 U. S. 849

" * * * The question of fact presented was resolved on conflicting and substantial evidence, and such evidence may not be re-weighed by an appellate court. * * * "

Hurt v. Cotton States Fertilizer Co. (C. C. A. 5, 1947), 159
F. (2d) 52, Cert. Den. 331 U. S. 828

"(1) As to No. 301, it will serve no useful purpose to detail the evidence as to each of the transactions under attack, nor to set out the findings of the district judge as to them. It is sufficient to refer to the rule which declares that the findings of the district judge must stand unless clearly erroneous, and to say that except as hereafter mentioned the evidence fully supports the findings."

Union Producing Co. v. White, et al. (C. C. A. 5, 1946), 157 F. (2d) 254, Cert. Den. 329 U. S. 792

" * * * Giving due regard to the opportunity of the trial court to judge of the credibility of the witnesses, we cannot say that its finding that fraud was practiced is clearly erroneous."

Iriarte v. United States (C. C. A. 1, 1946), 157 F. (2d) 105, Cert. Den. 335 U. S. 816

" * * * Rule 52(a) in so far as it makes findings of fact conclusive is a rule of appellate procedure (*United States v. Lambert*, 2 Cir., 146 F. 2d 469, 471), so that we cannot set aside an award of compensation in cases of this sort unless it is shown to our satisfaction that the trial court's appraisal of value is 'clearly erroneous' * * * ."

Davis v. Johnston, Warden (C. C. A. 9, 1946), 157 F. (2d) 64, Cert. Den. 331 U. S. 813

" * * * The findings are amply supported by evidence, are not clearly erroneous, hence should not be set aside. * * * ."

Albert ex rel. Buice v. Patterson (C. C. A. 1, 1946), 155 F. (2d) 429, Cert. Den. 329 U. S. 739

" * * * we take it that the above cases are no longer controlling but that now we cannot set aside findings of fact made by a district court in a habeas corpus case unless, giving due regard to the opportunity had by the trial court to judge the credibility of the witnesses, its finding is clearly erroneous. Rule 52(a). * * * ."

Merando v. Mathy (Ct. App. D. C., 1945), 152 F. (2d) 21, Cert. Den. 327 U. S. 804

"(5) Though there is direct conflict in the testimony regarding the amount of work completed under the subcontract, we do not observe that there was any clear error in the finding as to the percentage of completion, or the amount of profit calculated thereon. The Federal Rules of Civil Procedure require that we accept the District Court's findings of fact unless they be shown to be clearly erroneous."

Smith v. Federal Land Bank of Berkeley (C. C. A. 9, 1945),
150 F. (2d) 318, Cert. Den. 326 U. S. 764

“ * * * Rule 52(a) of the Federal Rules of Civil Procedure, 28 U. S. C. A. following section 723c, prohibits our setting aside findings of a district court unless clearly erroneous. * * * ”

Huffman v. Home Owners' Loan Corporation (C. C. A. 8, 1945), 150 F. (2d) 162, Cert. Den. 326 U. S. 758

“ * * * But the issue as to the alleged fact of the defendant's knowledge of the defect at the time of the letting was submitted to the court as trier of the facts, and its determination of the fact issue against the plaintiff is binding on this court unless clearly erroneous. * * * ”

F. H. McGraw & Co. v. Milcor Steel Co. (C. C. A. 2, 1945),
149 F. (2d) 301, Cert. Den. 326 U. S. 753

“ * * * The court below nevertheless did uphold Blackburn's allocation and concluded this debt not paid.

(3-7) To reach this conclusion the District Judge necessarily relied on his finding that no allocation of the payments was made at the time of their receipt; although appellants challenge it, there was no evidence to the contrary, and it must stand. * * * ”

Clarage Fan Co. v. B. F. Sturtevant Co. (C. C. A. 6, 1945),
148 F. (2d) 786, Cert. Den. 376 U. S. 727

“ * * * The District Court's finding of infringement was not clearly erroneous and under Rule 52(a) of the Federal Rules of Civil Procedure, 28 U. S. C. A. following section 723c, we are not permitted to set it aside. * * * ”

National Aluminate Corp. v. Permutit Co. (C. C. A. 8, 1944),
145 F. (2d) 175, Cert. Den. 324 U. S. 864

“ * * * The court having found that the disclosures of each of the patents sued on constituted invention, our study of the record on this appeal has been to determine whether such finding was clearly erroneous. * * * ”

Dize v. Maddrix (C. C. A. 4, 1944), 144 F. (2d) 584, Cert. Den. 323 U. S. 702; Cert. granted on other issues 324 U. S. 697

" * * * There was, however, substantial evidence to support the finding of the District Judge as to the number of hours worked by Maddrix, and the amount due to him under the Act, and certainly this finding is not clearly erroneous. Federal Rules of Civil Procedure, Rule 52(a), 28 U. S. C. A. following section 723e. It is accordingly binding on us."

Commercial Nat. Bank in Shreveport v. Parsons (C. C. A. 5, 1944), 144 F. (2d) 231, Cert. Den. 323 U. S. 796

" * * * Findings of fact may not be set aside unless clearly erroneous, and due regard must be given to the opportunity of the trial court to judge of the credibility of the witnesses; * * * "

Skinner Mfg. Co. v. Kellogg Sales Co. (C. C. A. 8, 1944), 143 F. (2d) 895, Cert. Den. 323 U. S. 766

" * * * Under the evidence, the issue was one of fact to be tried and determined by the trial court, and its determination is binding upon this Court. * * * "

United States v. 62 Packages, etc. (C. C. A. 7, 1944), 142 F. (2d) 107, Cert. Den. 323 U. S. 731

"(1) Our essential question is whether the evidence is such as to justify us in saying as a matter of law that the District Court's finding * * * is erroneous. Obviously the finding should not be set aside unless clearly against the weight of the evidence. * * * "

Schwarz v. Witwer Grocer Co. (C. C. A. 8, 1944), 141 F. (2d) 341, Cert. Den. 322 U. S. 753

" * * * The findings of fact made by the district court, unless clearly erroneous, will be taken by this court as the facts. * * * "

Egner v. E. C. Schirmer Music Co. (C. C. A. 1, 1943), 139 F. (2d) 398, Cert. Den. 322 U. S. 730

" * * * We cannot say that the findings of fact by the trial court were clearly erroneous. * * * "

Columbian Nat. Life Ins. Company v. Goldberg (C. C. A. 6, 1943), 138 F. (2d) 192, Cert. Den. 321 U. S. 765

" * * * This court is not concerned with the preponderance of the evidence. Findings of fact of a district court must not be set aside, unless clearly erroneous. * * * "

O'Hara v. Murphy, et al. (C. C. A. 1, 1943), 137 F. (2d) 154, Cert. Den. 320 U. S. 795

" * * * * The issues turn on conflicting testimony where credibility must be the determining factor. Under such circumstances it is axiomatic that an appellate court will not reverse the findings of judge or master who heard and saw the witnesses unless the error is clear beyond dispute. ' * * "

United States v. Cushman (C. C. A. 9, 1943), 136 F. (2d) 815, Cert. Den. 320 U. S. 786

" * * * We nevertheless have examined the evidence and have satisfied ourselves that it does support the findings, that the findings are not clearly erroneous, and that therefore we ought not to set them aside. * * * "

Crosby v. Pacific S. S. Lines (C. C. A. 9, 1943), 133 F. (2d) 470, Cert. Den. 319 U. S. 752

" * * * There was a finding that appellee negotiated the sales without the aid of any broker, which clearly negatives any idea that appellant was the procuring cause of the sales. Was that finding clearly erroneous? Federal Rules of Civil Procedure, Rule 52(a); General Orders in Bankruptcy, No. 36 and 49(2), 11 U. S. C. A. following section 53.

(4) Under the record, as it now stands, we cannot set the finding aside. * * * "

Middle West Const. v. Metropolitan Dist. (C. C. A. 2, 1943),
133 F. (2d) 468, Cert. Den. 320 U. S. 737

“ * * * Many authorities dealing with situations involving construction contracts have been cited in the appellant's briefs, but in our opinion the principles of law they announce are inapplicable to the contract in suit under the facts found by the trial judge; and these findings we must accept unless they are shown to be clearly erroneous. * * * ”

MacDonnell v. Capital Co. (C. C. A. 9, 1942), 130 F. (2d)
311, Cert. Den. 317 U. S. 692

“ * * * the District Court made its findings of fact, as outlined above, on this conflicting evidence. Under the Federal Rules of Civil Procedure, rule No. 52a, 28 U. S. C. A. following section 723c, these findings may not be set aside unless ‘clearly erroneous’, and due regard must ‘be given to the opportunity of the trial court to judge of the credibility of the witnesses.’ ”

American Ins. Co. v. Scheufler (C. C. A. 8, 1942), 129 F.
(2d) 143, Cert. Den. 314 U. S. 575; 317 U. S. 687; 317
U. S. 712

“ * * * The findings of the court are presumptively correct and should not be set aside unless clearly erroneous. * * * ”

Kelly v. Johnston (C. C. A. 9, 1942), 128 F. (2d) 793, Re-
hear. Den. 317 U. S. 699; 318 U. S. 798

“(2) The lower court found against appellant on each of the other issues, and those findings may not be set aside here unless clearly erroneous. * * * ”

Hartford Accident & Indemnity Co. v. City of Sulphur (C. C. A. 10, 1941), 123 F. (2d) 566, Cert. Den. 315 U. S. 805

" * * * The evidence presented an issue of fact for the trial court, and it was resolved against the city. It cannot be said that the finding was clearly erroneous, due regard being had for the opportunity of the trial court to see and observe the witnesses as well as their demeanor while testifying. The finding must therefore stand on appeal. * * * "

Corbett v. Halliwell (C. C. A. 2, 1941), 123 F. (2d) 331, Cert. Den. 315 U. S. 818

" * * * The appeal raises only the question of the sufficiency of the evidence to support the findings and judgment. In actions tried upon the facts without a jury, findings of fact made by the court shall not be set aside unless clearly erroneous. * * * "

McIntosh v. Wiggins (C. C. A. 8, 1941), 123 F. (2d) 316, Cert. Den. 315 U. S. 815

"(7-10) The court below has found as a fact that there was no fraud, accident or mistake with respect to the insertion in the decree of the Circuit Court of the City of St. Louis of the provision of which the appellant complains. That finding is conclusive upon the appellant and upon this Court unless clearly erroneous. * * * "

Electro-Metallurgical Co. v. Krupp Nirosa Co. (C. C. A. 3, 1941), 122 F. (2d) 314, Cert. Den. 314 U. S. 699

"(2) Coming to the main problem at hand, that of prior practice, we are bound to accept the findings of the trial court, for no clear error appears therein. * * * "

Buckley v. Christmas (C. C. A. 4, 1941), 121 F. (2d) 323, Cert. Den. 314 U. S. 679

" * * * In view of the testimony of both the appellant and the appellee, above referred to, we are of opinion that the action of the District Court in refusing to allow appellant's first counterclaim, being based purely upon a finding of fact, was not clearly erroneous, and therefore it will not be disturbed by us. * * * "

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Supreme Court of the United States

October Term, 1948

No. 582

HAZELTINE RESEARCH, INC.,
Petitioner,

vs.

GENERAL MOTORS CORPORATION,
Respondent.

REPLY BRIEF FOR PETITIONER.

Respondent, having fortuitously won below on the erroneous refusal of the Court of Appeals to accept a pivotal finding of fact by the District Court, now seeks to avoid review by this Court on the pretense that the decision of the Court of Appeals hinged merely on "a question of law" (Respondent's Brief, p. 8), apparently *in vacuo*. Certainly the District Court found, as a fact, *a continuity of disclosure* of the subject matter in issue between the patent here involved and its antecedent parent application. Certainly the Court of Appeals predicated its own decision *on a rejection of that finding and on an unwarranted substitution of its own finding of variance of disclosure*.

Petitioner seeks certiorari to correct the error of the Court of Appeals in erroneously setting aside the District Court's finding of fact *as a prerequisite* to its own decision on "a point of law".

The Brief for Respondent contains a number of statements which it is believed are inaccurate or misleading and require comment and these will be considered in the order of their appearance in Respondent's Brief.

I. Statement of Facts.

1. Respondent suggests (Brief, p. 3) that Petitioner implied that the descriptions of the figures added to the patent in suit were found in the original application. No such statement or implication is found in the Petition. It is Petitioner's position that the descriptions of the figures common to the original application (Figs. 1 and 4) and the patent in suit (Figs. 1 and 2) are also substantially common. These are the figures essential to this controversy.*

2. Respondent (Brief, pp. 4, 5) points to the lack of the term "peak detector" in the original application. This term was merely a convenient short title admittedly coined at a later date to identify the detector completely illustrated and described in both the original application and the patent in suit. This type of detector was defined in the "Glossary of Terms" (R. 1689) cited with approval by Respondent (Brief, p. 5). *Every element* of this apparatus *defined by the claims in suit* is fully disclosed in the *original application*, even to the sizes and values of the circuit elements. In the plate opposite R. 1756, typical claims in suit are applied in detail to the disclosures of both the original application and the patent in suit, with reference to Attachments 1, 2, and 3 (R. 1764A, 1764B, and 1764C).

* Of the figures added to the patent in suit, Figs. 3, 4, and 6 are solely explanatory in nature and *not essential* to the disclosure of the claimed invention; Figs. 5, 7, 8, 9, and 10a-10h, inclusive, illustrate other modified forms of the invention none of which is essential to the disclosure of the claimed invention.

3. Respondent inadvertently agrees with the foregoing statement of facts when it says:

“ * * * ‘Peak detection’ involves the use of the same elements as are shown in the original application, but requires in addition that there shall be applied to the *diode* (the two-electrode tube common to the circuits of both applications) a sufficiently high (i. e. strong) signal. When that is done, *the peak detection effect is inevitably obtained*, * * * ” (Emphasis Respondent’s; Brief, p. 5).

However, Respondent is in error in implying that the original application did not teach supplying a strong signal to the detector. The original application states that there are advantages attending the application to the detector of a signal voltage “*when this voltage is large*” and that the associated control circuits require a “*large operating voltage, say ten volts*,” which is proportional to the voltage applied to the detector (R. 1397).

Thus, Respondent effectively admits that the peak detector defined by the claims in suit is “inevitably” fully disclosed in the original application.

II. Argument.

1. Respondent states

“ * * * it is quite true that the drawings of the original 1927 application, show parts which, when properly arranged and operated, gave rise to peak detection; *but peak detection as such was not described* as a part of that application * * * ” (Emphasis added; Brief, p. 8).

and elaborates (pp. 8-10) on this theme that the magic words “peak detection” are not found in the original application. This is but a skillful exercise in semantics. It is immaterial that a convenient short title was later coined for Wheeler’s

radically new peak detector; what is *important* is that the *elements of the apparatus claimed* in the patent in suit *were disclosed* in the original application; then, as admitted in the foregoing quotation from Respondent's Brief, "the peak detection effect is inevitably obtained". It is a new example of the old adage that a rose by any other name smells as sweet.

Insofar as the material added to the patent in suit represents an enlarged theoretical explanation of the invention (Figs. 3 and 4; specification page 1 and page 3, line 142 to page 5, line 45; R. 889, 893, 895-897), such an enlargement is authorized by a long line of unquestioned authorities. As was said by the Court of Appeals for the Sixth Circuit in *Michigan Carton Co. v. Sutherland Paper Co.*, 29 F. (2d) 179, 184:

"The rule is that insertions by way of amendment in the description or drawing, or both, of a patent application (fol. 1764) do not invalidate the patent, if they are only in amplification and explanation of what was already reasonably indicated to be within the invention; and this rule applies with special force where the insertion was required by the Patent Office. *General Electric Co. v. Cooper, etc., Co.* (C. C. A. 6), 249 F. 61, 64, certiorari denied 246 U. S. 668, * * *. *And if an inventor comes to better understand the principles of his invention while his application for patent is pending, an amendment of his claim to conform thereto does not introduce any original matter nor enlarge his invention, and is within his legal rights.*" (Citing cases; emphasis added.)

On this point, see the Petition for Rehearing (R. 1757-1759).

2. Respondent cites (Brief, p. 10) *Muncie Gear Works v. Outboard Company*, 315 U. S. 759 for the proposition that the Court of Appeals was right. That case is irrelevant to the facts of this Petition since, as appears from the very

quotations in Respondent's Brief, the decision was based solely on the fact that the description of the patent in suit was substantially changed after its filing to describe an anti-cavitation plate and *the novel feature of the claims in that suit was predicated entirely on the added description*. Originally, neither the specification *nor the drawing* showed the later-claimed construction. In the present case there is no question but that the claims in suit are bottomed squarely on the unchanged original drawings *and specification* carried over into the patent in suit.

3. In its discussion of the decision of the District Court (Brief, pp. 11-12) Respondent makes several misleading statements. It would have this Court believe that the District Court's conclusion that the Petitioner "had made out a pretty good case here" (R. 880) was a tentative preliminary remark. It further states that the District Court, immediately preceding such statement, said that Petitioner had "a pretty tough row to hoe". The facts are that the District Court's statement that Petitioner "had made out a pretty good case here" was made *after* the conclusion of a three weeks' trial; *after* a thorough consideration of exhaustive briefs; and *after* a full day's final argument of counsel. The comment of the District Court on Petitioner's burden of proof, on the other hand, was made *four months prior to*, not immediately preceding, the Court's remark quoted by Petitioner and *before* consideration of any of the briefs and *before* the final argument of the case.

Petitioner has not made any attack on the District Court nor has it attempted to estop the District Court as to its disposition of the case, as suggested by Respondent (Brief, pp. 12, 13). Petitioner has merely pointed out that it is clear that the District Court was overawed by the decision of this Court in *Detrola v. Hazeltine*, 313 U. S. 259 and

erroneously considered itself bound thereby to find against Petitioner in spite of its own independent judgment to the contrary, as evidenced by its statement that Petitioner "had made out a pretty good case here".

Respectfully submitted,

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Attorney for Petitioner.

PHILIP F. LaFOLLETTE,
LEONARD A. WATSON,
LAURENCE B. DODDS,
Of Counsel.

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MAR 11 1949

CHARLES ELMORE CHAPLEY
CLERK

Supreme Court of the United States

October Term 1948

No. 582

HAZELTINE RESEARCH, INC.,

Petitioner,

against

GENERAL MOTORS CORPORATION,

Respondent.

BRIEF FOR RESPONDENT

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Supreme Court of the United States

October Term 1948

No. 582

HAZELTINE RESEARCH, INC.,

Petitioner,

against

GENERAL MOTORS CORPORATION,

Respondent.

BRIEF FOR RESPONDENT

The Petitioner seeks a review only as to patent No. 1,951,685. The other patent, No. 2,041,273, is not presented. The petition does not set forth the underlying facts sufficiently.

Statement of Facts

The '685 patent is but one of seven patents which grew out of a single application filed in 1927, and which was the description, in essence, of a receiver which had been made by Wheeler, the patentee, late in 1925 or early 1926. It was a receiver for broadcast radio waves or signals, referred to in the findings as the Washington Receiver.

The trial Court made this finding (R. 1720), which is not attacked here, nor was it in the Court of Appeals:

"3. On July 7, 1927, Wheeler filed his application, serial number 203879, describing all of the features of his Washington Receiver. This application

was assigned to plaintiff's predecessor corporation. Under the guidance of skillful patent counsel, on the basis of this one application and divisions and continuations thereof, plaintiff's predecessor corporation secured the following seven patents, each containing numerous claims, all based upon the combination embodied in the Washington Receiver, viz:

<i>Patent No.</i>	<i>Issue Date</i>	<i>Title</i>
1,879,861	Sep. 27, 1932	Volume Control
1,879,862	Sep. 27, 1932	Volume Control
1,879,863	Sep. 27, 1932	Volume Control
*1,951,685	Mar. 20, 1934	Peak Detector
Re.19,744	Oct. 29, 1935	Volume Control
**2,041,273	May 19, 1936	Amplifier Volume Control
2,080,646	May 18, 1937	Visual Resonance Indicator

[* Here in suit.]

[** Here in suit (but not before this Court).]

"The claims of these various patents are couched in such language as to make it extremely difficult for the mere mechanic skilled in the art to determine where one patent begins and another leaves off.

"Figures 1 and 2 of the '685 patent in suit are substantially identical with their counterparts in the original application. The application of this '685 patent [the one here presented], serial number 526,857, was filed April 1, 1931, as a *continuation-in-part*¹ of the original application. The application for the '273 patent in suit was filed August 27, 1932, as a division of the original application. Figures 1, 2, 3 and 4 of the '273 patent are substantially identical with their counterparts in the original ap-

¹ In quoting from this finding, on page 17 of their brief, counsel for petitioner have omitted this sentence, which shows by the words "*continuation-in-part*" that the application had added to the disclosure of the original application.

plication. The accompanying descriptions in the specifications of both these patents are substantially identical with that appearing in the original application." (Italics in the foregoing, and throughout this brief, indicate our emphasis.)

The last sentence of the finding obviously refers only to the descriptions of the figures that are common to the original application, and not (as inferred by petitioner) to the *fifteen new* figures and 5 pages of description in the '685 patent all of which were first added in 1931 (R. 1116; 1163).

The *reissue* patent 19,744 was the one declared invalid by this Court as the result of litigation thus described by the trial Court in its findings, which are not attacked here (R. 1721):

"4. Originally, Wheeler claimed the principal novelty disclosed in his Washington Receiver was the automatic volume control covered by patent 1,879,863. This patent was involved in litigation in the District Court for the Eastern District of New York in 1934. See: *Hazeltine Corp. v. R. E. B. Service Corp.*, 8 F. S. 100. At that time Judge Campbell carefully reviewed the prior art, part of which is relied upon in the instant cases, and found that the patent was not a pioneer and was entitled to only a narrow range of equivalents, dismissing the complaint on the ground of non-infringement. In 1934, this patent was also carefully considered by Judge Galston in the Eastern District of New York. See: *Hazeltine Corp. v. Abrams*, 7 F. S. 908. He held all of the claims in suit void for want of invention. This decision was affirmed by the Second Circuit Court of Appeals in *Hazeltine Corp. v. Abrams*, 79 F. (2) 329.

"After the decision in the *Abrams* case, all of the claims in the patent there involved were disclaimed, and an application was filed for a reissue, which culminated in the Reissue Patent No. 19,744.

"Plaintiff's predecessor corporation brought suit in this district for infringement of this Reissue Patent No. 19,744 which was decided December 26, 1939, holding all claims in suit, 1-7 and 9-13, inclusive, valid and infringed. Claim 8 was not in suit. On appeal, the Sixth Circuit Court of Appeals affirmed. See: *Detrola Radio & Television Corp. v. Hazeltine Corp.*, 117 F. (2) 238. This decision was reversed by the Supreme Court in *Detrola Radio & Television Corp. v. Hazeltine Corp.*, 313 U. S. 259. After a full consideration of the prior art and a consideration of the opinions of the Second and Sixth Circuit Courts of Appeal, the Supreme Court, speaking through Mr. Justice Roberts, stated, on page 269;

'We conclude that Wheeler accomplished an old result by a *combination of means* which, singly or in similar combination, were disclosed by the prior art, and that notwithstanding the fact he was ignorant of the pending applications which antedated his claimed date of invention and eventuated into patents, he was not in fact the first inventor, since his advance over the prior art, if any, required only the exercise of the skill of the art.' "

The patent in issue here is for a "Peak Detector"; peak detection was not described as such, or claimed, in the original application of 1927. A "peak detector" is thus de-

fined in the "Glossary of Terms" and is not in dispute (R. 1689):

"Peak Detector. A detector in series with a condenser having a high-resistance leakage path, the arrangement being supplied with a sufficiently strong signal so that current flows through the detector only in the neighborhood of the peaks of one polarity. This process is *peak detection*."

The *reissue* patent, which was declared invalid by this Court, was for "automatic volume control". "Peak detection" involves the use of the same elements as are shown in the original application, but requires in addition that there shall be applied to the *diode* (the two-electrode tube common to the circuits of both applications) a sufficiently high (i.e. strong) signal. When that is done, *the peak detection effect is inevitably obtained*, and, as in the case of automatic volume control, by mere operation of the elements producing automatic control (R. 459-60; 1478).¹ To make a disclosure of "peak detection", the specification of the patent in suit added 15 figures of drawings not in the original application, and five pages of description of them and of the entire "peak detection" action.

In 1926 Wheeler, in endeavoring to commercialize his asserted automatic volume control invention, went to the

¹ In fact, "automatic volume control" (considered by this Court in *Detrola Radio & Television Corp. v. Hazeltine Corp.*, 313 C. S. 259) requires an element (a connection back to the amplifier grid) *not* required for peak detection. Thus the *latter* is only a part of the combination held non-inventive in the decision cited.

factory of the Stromberg Carlson Company in Rochester, New York, where he modified a then-standard Stromberg Carlson "Neutrodyne" receiver to incorporate in it automatic volume control (R. 190; 264-5). He says that that set incorporated also the invention of the patent here before the Court (R. 1468). This receiver was *described* by Wheeler to a meeting of engineers from the Independent Radio Manufacturers, a group of Hazeltine licensees (R. 190; 287-8). It was also *demonstrated* to two of them (R. 287-8; 1469-70). That receiver was never built commercially (R. 265). In the summer of 1927, Wheeler went to the factory of the Howard Radio Company in Chicago and there built a number of "Neutrodyne" receivers embodying the invention of the patent here before this Court (R. 1470-71), and some were sold (R. 1471). On November 2, 1927, before the Institute of Radio Engineers in New York, Wheeler orally delivered a paper reproduced at R. 1653. This was not only delivered orally but was *published in printed form* at that time (R. 274, 1470). It also described automatic volume control and gave the circuit of the Howard receiver, which was similar to Figure 1 of the patent in suit (R. 1470) and the circuit shown in the diagram is admitted to embody the *purported* invention of the patent in suit (R. 1470). This paper was published also in the Proceedings of the Institute of Radio Engineers in January 1928 (*id.*).

Thus there was a description and demonstration in mid-1926, a sale in mid-1927, a publication at the end of

1927, and a publication again in 1928. This the Court of Appeals held to constitute a statutory bar against the patent in suit, which was not applied for until April 1931.

The *District Court* held that there was not enough advance in the patent in suit over the prior art to amount to invention. Its finding was as follows (R. 1726):

“9. The advance over the prior art, if any, disclosed in two patents in suit is much less than was disclosed in the *Detrola* case. Applying the standard of invention established by that case in the radio field, it is obvious that all Wheeler did was to accomplish an old result by a combination of means which singly or in similar combination were disclosed by the prior art. None of the claims in suit of either patent discloses an advance over the prior art beyond that which could be accomplished by a mechanic skilled in the art. All of the claims in suit are void for want of invention.”

The *Court of Appeals* did not pass upon the issue of patentable invention but held that the prior publication and use was such as to invalidate the patent because its application was not filed until 1931.

ARGUMENT

1. **The Issue Presented by Petitioner (Petition page 11) is a False Issue.**

We have no quarrel with the statement of law as presented at page 11 of the brief for petitioner. Therefore we shall not discuss the many authorities invoked to support the proposition that where a District Court has made an express finding of fact, on uncontradicted evidence, it should be followed by the Court of Appeals¹. But the facts do not support the applicability here of the proposition advanced by our adversaries.

That is to say, it is quite true that the drawings of the original 1927 application, show parts which, when properly arranged and operated, gave rise to peak detection; but peak detection as such was not described as a part of that application nor was any claim made to it. Nowhere in the 1927 application (R. 1371) is there found *any* description of "peak detection", nor was *that* alleged invention ever attempted to be claimed until the continuation-in-part application, for the patent now before this Court, was filed in April of 1931. The entire description of "peak detection" was newly added at that date, as were also the claims

¹ The Court of Appeals, in its opinion on the second petition for rehearing, said, properly, that the point of its decision was a *question of law* (R. 1768). That of course is always open to review. *U. S. v. Gypsum Co.*, 333 U. S. 364, at p. 394. Even upon an issue of fact, a finding is 'clearly erroneous' when although there is evidence to support it, the reviewing Court on the entire evidence, is left with the firm conviction that a mistake has been committed (*id.* p. 395). See also *Hall Laboratories v. Economics Laboratory*, 169 F. (2) 65, 67 (C. C. A. 8). *Graver Tank Co. v. Linde Air Products Co.*, — U. S. — (Feb. 28, 1949).

attempting to cover that subject-matter,—all more than two years after a statutory bar. As the Court of Appeals found,

“The whole concept of peak detection was included for the first time upon the filing of the divisional application.” (R. 1752)

It added:

“These five pages of the specification are devoted to explaining the operation of the peak detector, and the information therein set forth is not, upon careful analysis, to be found in the original application.”

The plaintiff was not content with the Court's holding, and it filed an elaborate petition for rehearing which was denied without opinion, and thereupon it filed a renewed petition for rehearing, of which the Court of Appeals said (R. 1768):

“Its unusual vehemence, its inexplicable assertion that decision was based upon an issue of fact not presented by the parties but interjected into the case for the first time in the court's opinion, and its intemperate assertion that this ‘transcends the bounds of fair administration of justice’, compels a considered response.”

The Court thereupon restated its previous finding, as follows:

“Decision rested upon prior publication, use and sale beyond the permissible limits of the statute. The facts of publication, use and sale are not in controversy. Their legal effect upon the validity of the patent was and still is considered by us to raise

a *question of law*. The issue in this respect was fully argued by senior counsel for the appellee. * * * Our considered judgment was based upon a careful consideration of the disclosure of the original application, and *finding therein no description of the invention of the patent in suit* and adjudging the law to be that drawings alone are not sufficient to comply with the statutory imperative for full disclosure, we held the divisional patent invalid. Such was our matured judgment after full consideration of oral argument and briefs; such was our judgment upon consideration of the original petition for rehearing; such is still our judgment upon consideration of the renewed petition for rehearing; * * *."

The Court Below Was Right

That the Court was right as a matter of law, upon the uncontroverted facts, is evidenced by its citation of authority at the bottom of page 1751 of the Record, and also by the decision of this Court in *Muncie Gear Works, Inc. v. Outboard Company*, 315 U. S. 759, at pages 767-8. There was involved a patent for an outboard motor, which included an element known as an anti-cavitation plate, of which the Court said (p. 761):

"The single sheet of drawing accompanying the application *was not changed* during the prosecution of the application, and is the same as the drawing of the issued patent."

And at page 762, with respect to the changes made in the claims:

"The effect of those changes was aptly described by the patent examiner: 'The amendments have been

such that the claims *now* emphasize the anti-cavitation plate rather than the anti-torque plate.' With changes which are immaterial here, the new claims so offered became the claims in issue."

For the reason that the plaintiff had sold devices with the anti-cavitation plate in them more than two years before submitting the changed claims, this Court held the claims invalid, saying:

"We think the conclusion is inescapable that there was public use, or sale, of devices embodying the asserted invention, more than two years before it was first presented to the Patent Office." (315 U. S. at p. 768)

We submit that the Court below was right in its disposition of the issue.

2. The District Court's Disposition of the Case.

There seems to be an effort in the early part of the petition to raise the question of the District Court's correctness in disposing of the case on the ground that there was not sufficient advance in the art shown in the patent in suit to take it out of the rule laid down by this Court in the *Detrola* case. In this connection, our adversaries give what they say is, "an analysis of the findings of the District Court" (Petition, p. 3) and assert that that Court "concluded that, on the basis of such testimony, Petitioner 'had made out a pretty good case here'." It supports this assertion by extensive quotations from remarks of the trial Judge *before* the case was submitted (Petition pp. 4, 5), and at page 5 it is said:

“The inescapable conclusion from the foregoing *analysis* is that Petitioner had established the validity of the patents in suit to the independent satisfaction of the Trial Court.”

We think that petitioner makes an unfair and unjustified attack upon the Trial Court. The remarks that are quoted were, as we have said, made *before the case was submitted*. But immediately preceding the quotations in the footnotes, the following occurred in a statement by the Court (Judge Lederle) to plaintiff's counsel, Mr. Dodds (R. 874):

“I do not think it is the kind of a case we ought to try to finish this afternoon. I do not think I can do justice to myself, or justice to you to try and finish it this afternoon, and what I would prefer is have you come back here, and I am under the impression—I do not want to frighten you—but *I am under the impression that you [plaintiff] have a pretty tough row to hoe.*”

Then, after the petitioner's quotations from the colloquy between Court and counsel, the trial Judge said:

“Now, then, on the other hand we have the Supreme Court decision [referring to this Court's opinion in the Detrola case]. I don't know that either one of you have been very much help to me on the thing that is causing me some concern, and that is this: *What was there left in this machine after the Supreme Court got through with it?*” (R. 880)

“As I see it, I have quite a lot of work left to do here. I have got a transcript of everything, and I will get a transcript of your argument and go over that by myself.” (R. 881)

Petitioner's attempt to "estop" the Trial Judge from making whatever disposition his study should lead him to, is without proper basis. Throughout the course of the trial, the Judge dealt frankly and helpfully with counsel on both sides by constantly disclosing what was then in his mind (e.g. R. 878 top, 756 top, 874), and by giving counsel an opportunity in argument to meet whatever the Judge might feel to be a consideration against the position being advanced at the time. What actually occurred was that some time after the trial and argument and submission of briefs, the Court made up its own mind and finally disposed of the case upon a set of findings of fact, which are embodied in the record at pages 1719-27.

We submit that the petition should be denied.

March 11, 1949.

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